U.S. Serial No. 10/657,693
Applicant: Higgs

REMARKS

Applicant would initially like to thank the Examiner for the helpful comments set forth in the Office Action dated January 23, 2009 in connection with the present application. In view of those comments, Applicant respectfully requests the Examiner to reconsider the present application after taking into account the above amendments and following remarks:

1. Rejection of Claims Under Section 101:

Claims 40-58 stand rejected on the grounds that they are directed to subject matter that is not eligible for a patent, and in particular, that under Section 101, a method or process claim must either be tied to another statutory class of invention (such as a particular apparatus) or physically transform the underlying subject matter (such as an article or material) to a different state or thing.

In response, Applicant has amended Claims 40, 46 and 53 to specify a method of "developing a shopping complex and encouraging retail tenants to occupy and lease space within said shopping complex," which Applicant respectfully submits overcomes the Examiner's rejection under Section 101, for the following reasons:

First, the method is now directed to "developing a shopping complex," which Applicant submits is "another statutory class of invention," since, clearly, a shopping complex is an apparatus, albeit a large one. That is, as long as the method or process is "tied" to something tangible, i.e., a shopping complex, which can be considered an apparatus, then, the statutory requirements of Section 101 is satisfied.

Second, a method used to "develop a shopping complex" is clearly one that transforms the underlying subject matter into a different state or thing, since, "developing a shopping complex" is the process by which the shopping complex is created, or, in other words, transformed from nothing into something. To develop something is essentially the same as transforming it, from one state to another, wherein the statutory requirements of Section 101 are satisfied.

For all of the above reasons, Applicant respectfully submits that the Examiner's rejection under Section 101 has been overcome.

2. Rejection of Claims Under Section 103:

Claims 40-58, including independent Claims 40, 46 and 53, stand rejected under Section 103 as being unpatentable over the article entitled "Burlington Outlet Opens At Commons Chain Fills Void Left By Kmart," by Ron Maxey, published March 13, 1997 (hereinafter "Maxey"), in view of the Wall Street Journal article, dated Dec. 4, 2000 entitled "Promotional Ties to Charitable Causes Help Stores Lure Customers" (hereinafter "Zimmerman").

In particular, the Examiner asserts that Maxey teaches a method of encouraging retail tenants to occupy and lease space within a shopping complex, and providing a shopping complex under common ownership having a plurality of individual spaces, etc., and while Maxey does not teach providing a physical microenvironment, the Examiner nevertheless asserts that Zimmerman teaches providing a physical microenvironment within the shopping complex comprising a common area having a theme associated with the goods and/or services sold by at least one individual retail tenant, i.e., along 20 blocks of Madison Avenue in New York including stores such as Armani and Zitomer.

a. The Activities Provided By Applicant's Method Extend Substantially Through Multiple Seasons Of The Year, Whereas, Zimmerman's Discount Program Only Lasts For 9 Days Out Of The Year.

The Examiner asserts that the shopping card promotional program of Zimmerman is an "ongoing activity" lasting 9 days each year. Upon carefully reviewing and considering Zimmerman's method, however, it should be clear that there are distinct differences between Zimmerman's method and Applicant's method, as follows:

Zimmerman is directed to a promotional discount activity run by merchants and charities that offers discounts for a limited time to shoppers who donate money to certain charities. More specifically, Zimmerman relates to a temporary promotional program that gives incentives for shoppers to donate to the participating charities. The program runs as follows: During the 9 day period, charities sell donation cards for a fixed price, wherein, when consumers buy the card, the money raised goes to the charities. But in return—during the 9 day period—the retailers are required to give

those consumers who bought the cards specified discounts on goods and/or services that they sell.

In Zimmerman, the program only lasts 9 days out of the year and therefore is not part of an ongoing business of the retail merchants. In fact, Zimmerman even discussed the many problems associated with making it an ongoing program which militates against them doing so. He states: "Some retailers find the programs frustrating because they are hard to plan for and the crowds can be overwhelming. . . . It's an imposition . . . Our sales go up so high, but our inventory is depleted. The chain has to bring in extra staff to handle the volume and it worries about becoming dependent on the programs for sales. . . ."

On the other hand, Applicant's method is intended to be part of the ongoing daily business of the shopping complex, and therefore, it should be clear that Applicant's method is substantially different from the 9 day discount program taught by Zimmerman. In this respect, Applicant recognizes the issues explained by the Examiner relative to the use of the term "OR" rather than "AND" and therefore has amended the claims as follows:

Claims 40, 46 and 53 have been amended to indicate that "said at least one activity comprises an ongoing activity that extends substantially through multiple seasons of the year (emphasis added)." Rather than running only 9 days out of the year, in Applicant's invention, the activities are intended to run throughout the year—through multiple seasons of the year, i.e., they are normal ongoing activities of the shopping complex. Clearly, Zimmerman does not suggest running his discount card program through multiple seasons of the year, and in fact, even suggests the opposite is true due to the difficulties that the program causes, i.e., excessive crowds, loss of inventory, need for extra staff, possible dependence on discounts, loss of margins, etc.

Therefore, it should be clear that Applicant's invention as now specified in Claims 40-58 is distinguishable over Zimmerman, and the combination of Zimmerman and Maxey.

b. The Specific "Entertaining" Activity Used In The Microenvironment Relates To One That Both Entertains Customers And Attracts Them To The Shopping Complex, In Addition To Promoting The Goods And Services That The Retail Tenants Sell, Which Is Not Suggested By The Prior Art.

Another aspect of Applicant's method that distinguishes it over the prior art is that Applicant's method includes a means of not only promoting the goods and services that are sold by the mall's retail tenants, but also a means of entertaining customers and attracting them to the mall, wherein the method comprises developers, mall owners and operators attracting customers by providing intrinsically entertaining activities in the mall on a long term basis.

In this respect, it should be clear that Zimmerman has nothing to do with providing intrinsically entertaining activities to attract customers to the shopping mall, but rather, Zimmerman's method simply provides a discount (lower prices) to those who purchase the charity discount card, which is what helps to attract the customers to the stores. In this respect, it should be clear that getting a lower price on something is not necessarily a form of entertainment, separate from promoting the goods and/or services that are sold by the tenants. That is, as now clearly specified in Claims 40, 46 and 53, Applicant's method comprises "conducting or having conducted at least one entertaining activity . . . designed to entertain customers and attract them . . . and have the effect of promoting . . . the goods and/or services sold by . . . said retail tenants."

Clearly, while providing a discount may help promote the goods and services of the retail tenants, discounts do not have intrinsic entertainment value that can entertain customers and attract them to the mall. Discounts are not a form of physical entertainment, at least not in the way the activities described in the specification, such as rock climbing walls, putting greens, driving ranges, wave pools, etc., are. For example, on page 8, lines 10-16, the specification states: "The present invention contemplates that mall developers will be able to attract prospective and desirable retail tenants by providing a microenvironment within the mall specifically designed to provide activities and entertainment that will help promote sales of the particular goods and services being offered for sale by the participating retail merchants. They are also

designed to be entertaining and enjoyable to consumers so as to attract customers to the mall and to the stores."

Likewise, although many existing malls have forms of entertainment being offered in the common areas of the mall, they are not specifically located in a microenvironment and adapted to promote the particular goods and services of specific retail tenants that occupy space in or near the microenvironment. For these reasons, it should be clear that Applicant's invention as specified herein is distinguishable over the combination of Maxey and Zimmerman.

3. Conclusion:

For all of the foregoing reasons, Applicant respectfully submits that the application is in condition for allowance, and earnestly requests the Examiner to enter a notice of allowance in this case.

Very Truly Yours,

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